

REMARKS**I. Introduction**

The following issues are outstanding in the present Office Action:

- The Examiner objects to the oath or declaration as defective because it does not identify the mailing address of each inventor and does not identify the city and either state or foreign country of residence of each inventor.
- Claims 25, 47, 59, 60 and 65 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
- Claims 25 and 65 are objected to because of informalities.
- Applicant must affirm election in response to restriction requirement.
- Claims 1-63 and 66-73 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,237,145 to Narasimhan (hereinafter *Narasimhan*).
- Claims 64-65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Narasimhan*.

Applicant traverses these rejections and requests reconsideration in light of the amendments and remarks contained herein. Claims 74-75 have been withdrawn pursuant to Applicant's election in response to the restriction requirement. Claims 1, 3, 12, 13, 16, 19, 20, 22, 26, 30, 37, 41, 47, 49, 59-66, 68-70 and 72 have been amended. Claims 6, 15, 23-25, 42-43 and 51 have been canceled. Claims 1-5, 7-14, 16-22, 26-41, 44-50 and 52-73 are pending in this application.

II. Objection to Oath or Declaration

The Office Action alleged that the oath or declaration is defective. However, Applicant respectfully submits that the oath/declaration and application data sheet submitted in connection with this application are in compliance with 37 C.F.R. 1.67(a), 1.63(c) and 1.76. Thus, Applicant requests that this objection be withdrawn.

III. 35 U.S.C. § 112 Rejections

Claims 25, 47, 59, 60 and 65 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has amended the claims to address the Examiner's objections, and accordingly, Applicant respectfully requests that the rejections be withdrawn.

IV. Claim Informalities

Claims 25 and 65 stand objected to for informalities. Applicant has addressed such informalities. Specifically, claim 25 has been canceled, and claim 65 has been amended to depend from claim 64. Accordingly, Applicant respectfully requests that the objections be withdrawn.

V. Election in Response to Restriction Requirement

Applicant affirms its provisional election made without traverse on December 5, 2007, to prosecute the invention of subcombination I, claims 1-73. Applicant has withdrawn claims 74-75.

V. 35 U.S.C. § 102(b) Rejections

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 66-73 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Narasimhan*. Applicant traverses this rejection.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *See* M.P.E.P. § 2131 (citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989)). Applicant respectfully asserts that the rejection does not satisfy these requirements.

A. Independent Claim 1 and Related Dependent Claims

Independent claim 1 has been amended to recite that the electronic device is mobile by incorporating the subject matter of claim 6 as well as by correcting informalities in the claim language. Thus, no new matter has been added.

Independent claim 1, as amended, recites a method for distributing promotions comprising, in part, “transmitting data relating to said promotion to a mobile electronic device of said specific consumer.” *Narasimhan* fails to teach this limitation. Even assuming *arguendo* that the smart card is a mobile electronic device, data relating to a promotion is not transmitted to the smart card in *Narasimhan*. Rather, the smart card is merely used for redeeming coupons clipped and electronically stored in a database using the user’s home computer, and the user redeems the clipped coupons by visiting the merchant and inserting his/her smart card into a reader so that the user may be identified and the reader can access the coupons associated with the user. *See, e.g.*, column 6, lines 30-57. Accordingly, the smart card is merely an identification card for the user and not a mobile electronic device where data relating to a promotion is transmitted. *See, e.g.*, column 7, lines 10-31. Thus, *Narasimhan* does not teach this limitation of claim 1.

Claims 2-5 and 7-12 depend directly or indirectly from base claim 1 and thus inherit all limitations of base claim 1. However, each of these claims set forth features and limitations not recited by these references. For example, claim 3 recites “receiving a response from said mobile electronic device of said specific consumer.” *Narasimhan* does not teach this limitation as the smart card is unable to provide a response but merely identifies the consumer. *See, e.g.*, column 7, lines 10-31. Similarly, claims 7-8 are not taught by *Narasimhan* as text messages or voicemail messages are not transmitted from a smart card. Thus, Applicant respectfully asserts that for the above reasons, claims 2-5 and 7-12 are patentable over the 35 U.S.C. § 102(b) rejection of record.

B. Independent Claim 13 and Related Dependent Claims

Independent claim 13 has been amended to recite that the method of receiving and redeeming promotions is via a mobile electronic device by incorporating the subject matter of claim 15. Thus, no new matter has been added.

Independent claim 13, as amended, recites, in part, “a method of receiving and redeeming promotions via a mobile electronic device.” *Narasimhan* does not teach this limitation. A user utilizes the smart card disclosed in *Narasimhan* to identify himself/herself to the merchant system to redeem a promotion at a merchant location, but the user does not receive and redeem promotions using his/her smart card. Rather, the user typically clips the coupon while sitting at his/her personal computer, and the smart card is merely used to identify the user to the merchant system at the time of redeeming the promotion. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, independent claim 13 should be deemed patentable over the rejection of record.

Further, amended independent claim 13 recites, in part, “accessing, with said mobile electronic device, data, relating to said promotion, transmitted to said mobile electronic device from a server.” *Narasimhan* fails to teach this limitation. Again, the smart card of *Narasimhan* is merely identifying the user to the system so that the user may be identified and the reader can access the promotions associated with the user. The smart card is not a mobile electronic device accessing data relating to a promotion. Further, data relating to a promotion is not actually transmitted to the smart card. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. As such, claim 13 is patentable over the rejection of record.

Independent claim 13 also recites, in part, “redeeming said promotion by replying to said server using said mobile electronic device.” *Narasimhan* fails to teach this limitation. The smart card does not include a mechanism such that a user may redeem a promotion by replying to the server using the smart card. Rather, the smart card is merely used to identify the user to the system so that the user may be identified and the reader can access the coupons associated with the user. *See, e.g.*, column 6, lines 30-57. Thus, claim 13 is patentable over the rejection of record.

Claims 14 and 16-21 depend directly or indirectly from base claim 13 and thus inherit all limitations of base claim 13. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 14 and 16-21 are patentable over the 35 U.S.C. § 102(b) rejection of record.

C. Independent Claim 22

Independent claim 22 has been amended to specify that the method of distributing a promotion involves sending promotion data to a consumer web portal account accessible on a mobile electronic device of a consumer and saving the promotion in a promotion saving account accessible by the mobile electronic device wherein the consumer redeems the promotion using the mobile electronic device. Independent claim 22 incorporates the subject matter of claims 23-25 and also has been amended to address informalities in the claim language. Thus, no new matter has been added.

Independent claim 22 recites, in part, a method for distributing a promotion comprising, in part, “sending promotion data to a consumer web portal account accessible on a mobile electronic device of said consumer.” *Narasimhan* fails to teach this limitation. While a promotion may be sent via the web to a consumer’s computer in *Narasimhan*, the consumer web portal account is not accessible on a mobile electronic device. The smart card of *Narasimhan* is not a mobile electronic device but even assuming *arguendo* that it is, the smart card does not permit access to a consumer web portal account. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, claim 22 should be deemed patentable over the rejection of record.

Further, independent claim 22 recites, in part, “saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS).” *Narasimhan* fails to teach this limitation. A consumer in *Narasimhan* utilizes a smart card to identify himself/himself so that the smart card reader can access the consumer’s account, but the consumer does not redeem the promotion using the smart card. Rather, the smart card of *Narasimhan* is merely identifying the user to the system so that the user may be identified and the reader can access a promotion associated with the user. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. *Narasimhan* also fails to teach that a promotion saving account is accessible by the smart card. As such, this limitation is not taught by *Narasimhan*.

D. Independent Claim 26 and Related Dependent Claims

Independent claim 26, as amended, recites, a method for distributing a promotion comprising, in part, “transmitting data relating to said promotion to a mobile electronic device of said consumer.” *Narasimhan* fails to teach this limitation. Specifically, no data relating to a promotion is transferred to the smart card disclosed in *Narasimhan*. Rather, the smart card merely identifies the consumer to the merchant system so that the merchant system may determine the promotions that the consumer is eligible to receive. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. As such, this limitation of independent claim 26 has not been met.

Claims 27-29 depend directly or indirectly from base claim 26 and thus inherit all limitations of base claim 26. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 27-29 are patentable over the 35 U.S.C. § 102(b) rejection of record.

E. Independent Claim 30 and Related Dependent Claims

Independent claim 30, as amended, recites a method of distributing a promotion comprising, in part, “transmitting data relating to said promotion to a mobile electronic device of said consumer.” *Narasimhan* fails to teach this limitation. No data relating to a promotion is transferred to the smart card disclosed in *Narasimhan*. Rather, the smart card merely identifies the consumer to the merchant system so that the merchant system may determine the promotions that the consumer is eligible to receive. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, this limitation of claim 30 has not been met.

Claims 31-36 depend directly or indirectly from base claim 30 and thus inherit all limitations of base claim 30. However, each of these claims set forth features and limitations not recited by these references. For example, claim 35 recites that the requesting consumer contacts the distributor by calling a telephone number, sending an email message, or sending a text message. The smart card cannot be used to make such contact. Thus, Applicant respectfully asserts that for the above reasons, claims 31-36 are patentable over the 35 U.S.C. § 102(b) rejection of record.

F. Independent Claim 37 and Related Dependent Claims

Independent claim 37 has been amended to recite that the offer is transmitted to a mobile electronic device of a targeted consumer and a reply is received from the targeted consumer via the mobile electronic device of the targeted consumer in response to the offer. Support for these amendments may be found in at least paragraphs [0031]-[0032] of Applicant's specification. Thus, no new matter has been added.

Independent claim 37 recites a method for distributing a promotional offer to a targeted consumer comprising, in part, "transmitting said offer to a mobile electronic device of said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers." *Narasimhan* fails to teach this limitation. Specifically, offers are not transmitted to the smart card disclosed in *Narasimhan*. Rather, the smart card is used for identification purposes when the consumer reaches the merchant, and offers are merely transmitted to a user's computer for a user to review, and the smart card is used for identification when the consumer reaches the merchant to access offers that the consumer has accepted. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. As such, this limitation of claim 37 has not been met.

Independent claim 37 further recites "receiving a reply from said targeted consumer via said mobile electronic device of said targeted consumer in response to said promotional offer." *Narasimhan* also fails to teach this limitation. A consumer in *Narasimhan* does not reply to a promotional offer via a mobile electronic device. Rather, the consumer responds to a promotional offer while stationed at his/her computer, which is not mobile, and then uses the smart card to identify himself/herself to the merchant system at a later time. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, *Narasimhan* fails to teach this limitation of claim 37.

Claims 38-40 depend directly or indirectly from base claim 37 and thus inherit all limitations of base claim 37. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 38-40 are patentable over the 35 U.S.C. § 102(b) rejection of record.

G. Independent Claim 41 and Related Dependent Claims

Independent claim 41 has been amended to incorporate the subject matter of dependent claims 42-43. As such, no new matter has been added, and accordingly, claims 42-43 have been canceled.

Independent claim 41, as amended, recites a system for distributing and redeeming a promotion comprising, in part, “a mobile electronic device operable for transmitting a request for promotional data and for receiving generated promotional data.” *Narasimhan* fails to teach this limitation. As previously addressed, *Narasimhan* fails to teach a mobile electronic device. Even assuming *arguendo* a smart card is a mobile electronic device, the smart card disclosed in *Narasimhan* fails to transmit a request for promotional data. The smart card also fails to receive generated promotional data. See, e.g., column 6, lines 30-57, column 7, lines 10-31. As such, this limitation of claim 41 has not been met.

Claims 42-48 depend directly or indirectly from base claim 41 and thus inherit all limitations of base claim 41. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 42-48 are patentable over the 35 U.S.C. § 102(b) rejection of record.

H. Independent Claim 49 and Related Dependent Claims

Independent claim 49 has been amended to reflect that the consumer redeems the promotion using the mobile electronic device. The subject matter of dependent claim 51 has been incorporated into claim 49. Support for the amendments also may be found in at least paragraphs [0007], [0031], [0036]-[0038]. Thus, no new matter has been added.

Independent claim 49, as amended, recites a method for consumer contact comprising, in part, “matching said promotion with a merchant profile in a merchant profile database when said consumer accesses said promotion using said mobile electronic device in an electronic purchase.” *Narasimhan* fails to teach this limitation in that a consumer does not access a promotion using his/her smart card. Independent claim 49 further recites “transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein said promotion is generated from the profile of said consumer.” *Narasimhan* also fails to teach this limitation because data relating to a promotion is not transmitted to a smart

card in *Narasimhan*. Rather, the smart card is merely used to identify a consumer to the merchant so that the merchant can determine the promotion, if any, that should apply to the purchase. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, these limitations of claim 49 have not been met.

Claims 50-54 depend directly or indirectly from base claim 49 and thus inherit all limitations of base claim 49. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 50-54 are patentable over the 35 U.S.C. § 102(b) rejection of record.

I. Independent Claim 55 and Related Dependent Claims

Independent claim 55 is directed to a mobile electronic device comprising, in part, “means for requesting data regarding a promotion from a remote server” and “means for applying received promotion data when a purchase is made at a point of sale (POS).” *Narasimhan* fails to teach these limitations. The Office Action identifies the smart card of *Narasimhan* as an alleged mobile electronic device. Even assuming *arguendo* the smart card is a mobile electronic device, the smart card does not request data regarding a promotion from a remote server. Further, the smart card does not include means for applying received promotion data. Rather, the smart card merely serves as a way to identify the consumer to the merchant when the consumer inserts the smart card into a reader at the merchant location. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, these limitations of claim 55 have not been met.

Claims 56-60 depend directly or indirectly from base claim 55 and thus inherit all limitations of base claim 55. However, each of these claims set forth features and limitations not recited by these references. For example, *Narasimhan* does not teach a mobile telephone as set forth in claim 58 including all of the components set forth in claim 55. Thus, Applicant respectfully asserts that for the above reasons, claims 56-60 are patentable over the 35 U.S.C. § 102(b) rejection of record.

J. Independent Claim 61 and Related Dependent Claims

Independent claim 61 has been amended to reflect that the electronic device is a mobile electronic device. Support for the amendments also may be found in at least paragraphs [0007], [0031], [0036]-[0038]. Thus, no new matter has been added.

Independent claim 61, as amended, recites a system for redeeming promotions comprising, in part, “means for receiving from said mobile electronic device associated with said particular consumer an acceptance of said promotion.” *Narasimhan* fails to teach this limitation. The smart card disclosed in *Narasimhan* fails to incorporate any mechanism for allowing a consumer to send an acceptance of a promotion from the smart card. *See, e.g.*, column 7, lines 10-31. Thus, this limitation of claim 61 has not been met.

Claims 62-63 depend directly or indirectly from base claim 61 and thus inherit all limitations of base claim 61. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 62-63 are patentable over the 35 U.S.C. § 102(b) rejection of record.

K. Independent Claim 66 and Related Dependent Claims

Independent claim 66 has been amended to reflect that received information comes from a mobile electronic device and at least a portion of said coordinated information is communicated to the mobile electronic device. Support for the amendments may be found in at least paragraphs [0022]-[0023] of Applicant’s specification. Thus, no new matter has been added.

Independent claim 66, as amended, recites a system for coordinating transactions comprising, in part, “a server for accepting over a temporarily established communication connection from anyone of a plurality of users information specific to one of many merchants, said information including data specific to a unique POS location of one of said merchants” and “means for coordinating said received information from a mobile electronic device of a specific one of said users with information available to said server pertaining to said unique merchant location.” *Narasimhan* fails to teach these limitations. The only information received from the smart card is for identification of the user, and thus, the smart card is not transmitting information including data specific to a unique POS location of one

of said merchants. As this type of information is not received from the smart card, it follows that it cannot be coordinated with information available to the server pertaining to the unique merchant location. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Thus, these limitations of claim 66 have not been met.

Independent claim 66 further recites “means for communicating at least a portion of said coordinated information to said mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotional information associated with said specific user.” *Narasimhan* also fails to teach this limitation. As previously discussed, *Narasimhan* does not teach the coordinated information. It follows that coordinated information is not transferred to the smart card of *Narasimhan*. Additionally, claim 66 recites that said coordinated information includes promotional information associated with a specific user; however, no promotional information is transmitted to the smart card of *Narasimhan*. *See, e.g.*, column 6, lines 30-57, column 7, lines 10-31. Accordingly, independent claim 66 should be deemed patentable over the rejection of record.

Claims 67-69 depend directly or indirectly from base claim 66 and thus inherit all limitations of base claim 66. However, each of these claims set forth features and limitations not recited by these references. For example, claim 68 recites “means at said server for accepting further information from said mobile electronic device... comprising acceptance information.” *Narasimhan* fails to teach that acceptance information is accepted from a smart card. Thus, Applicant respectfully asserts that for the above reasons, claims 67-69 are patentable over the 35 U.S.C. § 102(b) rejection of record.

L. Independent Claim 70 and Related Dependent Claims

Independent claim 70 has been amended to recite “accepting over a temporarily established communication connection from a mobile electronic device of any one of a plurality of users information specific to one of many merchants.” Independent claim 70 also has been amended to recite, in part, “coordinating said received information from said mobile electronic device” and “communicating at least a portion of said coordinated information to said mobile electronic device.” Support for the amendments may be found in at least paragraphs [0022]-[0023] of Applicant’s specification. Thus, no new matter has been added.

Independent claim 70, as amended, recites a method for coordinating transactions comprising, in part, “accepting over a temporarily established communication connection from a mobile electronic device of any one of a plurality of users information specific to one of many merchants, said information including data specific to a unique location of one of said merchants, said specific data pertaining to merchandise obtained from said merchant.” *Narasimhan* fails to teach this limitation. Information specific to one of many merchants, including data specific to a unique location pertaining to merchandise obtained from the merchant is not accepted from a mobile electronic device in *Narasimhan*. Moreover, no information is accepted by the smart card of *Narasimhan*. See, e.g., column 6, lines 30-57, column 7, lines 10-31. Thus, these limitation of claim 70 has not been met.

Independent claim 70 further recites “coordinating said received information from a said mobile electronic device specific one of said users with available information pertaining to said unique merchant location.” *Narasimhan* fails to teach this limitation. As previously discussed, no information specific to one of many merchants is accepted by the smart card of *Narasimhan*. As such, this information is not accepted by a mobile electronic device. Further, any received information is not coordinated with available information pertaining to a unique merchant location. See, e.g., column 6, lines 30-57, column 7, lines 10-31. Thus, this limitation of claim 70 has not been met.

Independent claim 70 also recites “communicating at least a portion of said coordinated information to said mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotions available to said specific one of said users pertaining to said obtained merchandise.” *Narasimhan* fails to teach this limitation. Again, coordinated information is not transmitted to a mobile electronic device in *Narasimhan*. Moreover, the smart card disclosed in *Narasimhan* does not receive communications including promotions. See, e.g., column 6, lines 30-57, column 7, lines 10-31. Thus, this limitation has not been met.

Claims 71-73 depend directly or indirectly from base claim 70 and thus inherit all limitations of base claim 70. However, each of these claims set forth features and limitations not recited by these references. For example, claim 72 recites “accepting further information from said mobile electronic device... comprising acceptance information.” No acceptance information is accepted from the smart card in *Narasimhan*. Thus, Applicant respectfully

asserts that for the above reasons, claims 71-73 are patentable over the 35 U.S.C. § 102(b) rejection of record.

VI. 35 U.S.C. § 103(a) Rejections

Claims 64-65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Narasimhan*. Applicant traverses this rejection. Claims 64-65 depend directly or indirectly from base claim 61 and thus inherit all limitations of base claim 61. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 64-65 are patentable over the 35 U.S.C. § 103(a) rejection of record.

VII. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 65003/P002US/10312242 from which the undersigned is authorized to draw.

Dated: March 7, 2008


Respectfully submitted,

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: March 7, 2008

Signature: 

(Lisa deCordova)

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